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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,010	02/09/2001	Gordon James Smith	ROC920000267US1	6426
7590	12/19/2003		EXAMINER	
Robert R Williams Patent Agent IBM Corporation Department 917 3605 Highway 52 North Rochester, MN 55901-7829			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/781,010	SMITH, GORDON JAMES	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tan Dean Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 July 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3...                    6) Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-12, 13-18, 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-12, 13-18, 19-20 are directed to "A method of automating charitable contributions in a gaming system", which is not within one of the classes of invention set forth in § 101.

The "method of automating charitable contributions in a gaming system" comprising the steps of (a) prompting a user with a gaming options, (b) enabling the user to pledge a contribution to an organization, (c) permitting the user to make a wager and partake in the gaming option, and (d) automatically making the contribution to the organization based on the pledge of step (b) and the results of step (c), as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "method of automating charitable contributions in a gaming system" comprising the steps of (a)-(d) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (inclusion of computer/computer automation) and are therefore found to be non-statutory. See *In*

*re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over INTERLOTTO (Article "InterLotto..Lottery).

As for claim 1, INTERLOTTO discloses a method for automating contributions in a gaming system comprising:

- (a) prompting the user with a gaming option;
- (b) enabling the user to make a contribution to an organization;
- (c ) permitting the user to make a wager and partake in the gaming option; and
- (d) Making a contribution to the organization.

See abstract. Note that the game system is carried out completely on the Internet system, therefore the contribution step is carried out automatically. As for the pledge limitation, this is inherently included or equivalent to "a portion of each prize pool" is automatically donated to charitable causes which the player selects. In other word, the player knows in advance that if he wins, a portion of the winning prize is donated automatically to a charity organization. Alternatively, the various adjustment of the contribution step based on steps (b) and (c) would have been obvious.

As for claim 2, this is taught in INTERLOTTO.

6. Claims 3-5, 7-8, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO.

As for claim 3, the selecting the size (or percent of winning) of the contribution is other well known variable (2<sup>nd</sup> variable) beside selecting the charity organization (which is taught by INTERLOTTO) is inherently included in INTERLOTTO or would have been obvious to do so to complete the contribution process. As for claims 4-5, these are inherently included in the teaching of INTERLOTTO since without the pledge to make contribution to charity organization, a player cannot win the prize. Therefore, there is an odd for winning based on making the contribution to the charities.

As for claim 7, this is taught in INTERLOTTO wherein the payout is function of step (b). As for claim 8, this is taught on 2<sup>nd</sup> paragraphs "all winnings are forwarded immediately into player's InterLotto accounts" which indicates the accumulating of the winnings and contributions during a series of gaming activities. As for claim 10, this is inherently included in the teaching of INTERLOTTO wherein personal accounts/funds

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of the user is entered into the system. As for claim 11, this is inherently included in the teaching of INTERLOTTO whereby contribution is made upon the user winning the prize. As for claim 12, this is inherently included in the teaching of INTERLOTTO whereby contribution is funded from the net proceeds of the gaming system.

7. Claim 6, 13-15, 17-18, 19-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO as applied to claims 1-5, 7-8, 10-12 above, and further in view of TORANGO (US 2003/00600279).

As for claims 6, 13, 19, the teachings of INTERLOTTO is cited above. TORANGO is cited to show well known teaching in the gaming art which is as the participant contributes more to the prize, the odds of winning the prize becomes smaller, giving the participant a better chance at winning the prize (see Fig. 7, [0012]). In other word, as % of contribution goes up, the odds or winning becomes smaller or higher chance of winning (i.e. investing 50\$ by buying 2 lottery tickets at \$25.00/ticket has more chances of winning the prize than investing only \$25 by buying 1 lottery ticket at \$25.00/ticket). The total contribution to the game or the total cost to the player can be in the form of the buying more tickets or portion or giving more to charity or donation in this case. Therefore, it would have been obvious that to modify the gaming step of INTERLOTTO by tying the winning percentage to the level of contribution to charities (or overriding the 1<sup>st</sup> incentive with a 2<sup>nd</sup> incentive selected from the group consisting of a 2<sup>nd</sup> odds of winning and a 2<sup>nd</sup> payout, wherein the 2<sup>nd</sup> incentive is greater than the 1<sup>st</sup> incentive) as taught by TORANGO to encourage increase the level of contribution to charities and chances for winning.

Claim 14 is rejected for the same reason set forth in claims 2 and 3 above.

Claims 15, 20 are rejected for the same reason set forth in claim 8 above. Claims 17, 18 are rejected for the same reason set forth in claims 10, 12 respectively above.

8. Claims 9, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO as applied to claims 1-5, 7-8, 10-12, 13-15, 17-18 above, and further in view of ZIARNO (US 6,253,998).

The teaching of INTERLOTTO is cited above. In another fundraising process, ZIARNO is cited to teach the use of a receipt generator (820) to mail or fax or send/forward multiple copies of the contribution to the contributor or attender or other agency for tax purposes since the contribution to charities is normally tax deductible (Fig. 15a, col. 9, lines 5-47). ZIARNO mentions that format can be accepted by the IRS which inherently monitor individual tax related issues or return. Therefore, it would have been obvious to modify the process of INTERLOTTO by automatically providing the information regarding the gaming option and the contribution the IRS as taught by ZIARNO to monitor tax related information if desired. Since everything in INTERLOTTO is done on the Internet, this step can be carried out automatically along with other functions.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Foreign: WO 96/25209 is cited a system for playing games.

2. NPL: [www.telnetgo2000.com](http://www.telnetgo2000.com) and the article "TELnet releases Online Charity..." discloses ways to raise funds for nonprofit charities online while participating in Lotto Sweepstakes games.

10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn  
December 9, 2003



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PRIMARY EXAMINER